

Remarks:

Applicant has carefully studied the non-final Examiner's Action mailed 11/29/2005, having a shortened statutory period for response set to expire 02/29/2006, and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings and numbered paragraphs that correspond to the centered headings and paragraph numbering employed by the Office, to ensure full response on the merits to each finding of the Office.

The Office Action Summary indicates that the Examiner accepts the drawings filed 19 March 2004. However, Applicant filed two (2) preliminary amendments, both of which included drawing changes. The first preliminary amendment was filed 10 May 2004 and the second was filed 19 May 2004. The Office is requested to indicate in its next communication whether or not these preliminary amendments have been entered.

Elections/Restrictions

1. Applicant acknowledges the Office's finding that the invention of claims 1-8, reciting a method, is distinct from the invention of claims 9-16, reciting a tool.
2. Applicant acknowledges the Office's summary of MPEP § 806.05(e).
3. Applicant acknowledges the Office's finding that restriction for examination purposes is proper.
4. Applicant thanks the Office for acknowledging Applicant's election of Group 1, claims 1-8. Applicant hereby affirms said election of claims 1-8 and claims 9-16 are canceled.

Claim Rejections – 35 U.S.C. § 112

5. Applicant acknowledges the quotation of 35 U.S.C. § 112, first paragraph.
6. Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, because the limitation in claim 1, "rotating said device against said vertical support surface until said tile support surface is coincident with said elongate level marker" is not described in the specification. This ground of rejection is met by amending said limitation to recite that the tile support surface of the device is placed into registration with a mark formed on a vertical support surface and rotated against the vertical support surface until a spirit level indicates that the tile support surface is horizontal. This brings the claim language into conformity with paragraph

[0055] of the specification as amended. The amendment made to said paragraph [0055] brings said paragraph into conformity with claim 1 as filed so that neither the claim amendment nor the specification amendment introduces new matter into the specification.

Claim Rejections – 35 USC § 103

7. Applicant acknowledges the quotation of 35 U.S.C. § 103(a).

8. Claims 1-4 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Hannay and admitted prior art. Reconsideration and withdrawal of this ground of rejection is requested in view of the amendment made to claim 1.

As currently amended, claim 1 can no longer be construed as describing Applicant's contribution as well as the prior art represented by Smith, Hannah, and the admitted prior art.

Regarding claims 1-4, the Office contends that Smith is silent as to the pin holes being elongated and axially misaligned but that Hannay supplies such features. This finding of the Office is respectfully traversed because Hannay teaches elongate nail slots only in the context of overlapping plates. As Hannay discloses on the last two (2) lines of the first page of text and the first eight (8) lines of the second page of text:

The two plates 12 and 13 overlap each other, and long slots 14 are provided in their overlapping portions which slots on the two plates are aligned, and a pair of headed rivets 15 project through the two slots 14 which rivets act to hold the overlapping portions of the two top plates 12 and 13 together, but will yet permit extension of the two plates from each other, so that the two plates may overlap each other, more or less.

There are no overlapping parts in Applicant's construction. Thus, the Hannay disclosure of elongated nail-receiving slots formed in overlapping plates for the purpose of enabling the plates to slide with respect to one another (to adjust the overall length of the assembly of plates) would not have suggested elongated slots in a structure having no overlapping parts.

In fairness to Applicant, the Office should acknowledge that Applicant's structure has no overlapping, extendible parts and that Applicant is the first to provide a tile supporting device with elongated slots. As pointed out in the specification, Applicant's slots enable an installer to locate a stud underlying a wall, and to position a fastener through a slot into the stud, without limitation as to where the stud might be.

Moreover, the slots of Hannay, being formed only in the overlapping plates, do not extend the entire extent of the part formed collectively by the overlapping plates. A stud may be

present behind a plate at an unslotted extent of said plate and when the Hannay structure is used, such stud is unavailable as a support. Claim 1, as currently amended, recites this important feature of Applicant's invention. As aforesaid, Applicant's slots enable an installer to locate a stud underlying a wall, and to position a fastener through a slot into the stud, without limitation as to where the stud might be. Smith, even when modified by Hannay and the admitted prior art, still would not have taught the invention of claim 1, as currently amended, to one of ordinary skill in the art.

It is also significant that Hannay discloses a structure having utility in applying a trim to a door or window opening "to assure the construction of smooth and straight plaster surfaces adjacent the doorways." (first page of text, lines 4-6). Such a structure is not prior art in the field of tile installation because tiles are installed on walls or floors and not on the narrow peripheral edges of door and window openings. However, even if Hannay is accepted as a part of the prior art, it still would not have suggested to one of ordinary skill the claimed invention at the time the claimed invention was made.

Regarding claim 6, said claim is in condition for allowance because it depends from claim 1.

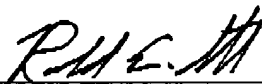
9. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannay and admitted prior art as applied to claim 1, and further in view of Sykes. Although the passive lug and recess coupler of Sykes would not have suggested Applicant's positive coupler, claim 5 is allowable as a matter of law because it depends from claim 1, currently amended.

10. Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannay and admitted prior art as applied to claim 1, and further in view of Masuda. Although guard rail-bending notches 6 of Masuda would not have suggested Applicant's equidistantly spaced notches, claims 7 and 8 are allowable as a matter of law because they respectively depend from claim 1, currently amended.

A Notice of Allowance is solicited. If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested. Applicant thanks the Office for its careful examination of this important patent application.

Very respectfully,

SMITH & HOPEN

By: 

Dated: January 11, 2006

Ronald E. Smith
Suite 220
15950 Bay Vista Drive
Clearwater, FL 33760
(727) 507-8558
Reg. No. 28,761
Attorneys for Applicant

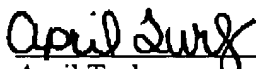
pc: Mr. Mark E. Kirby

CERTIFICATE OF FACSIMILE TRANSMISSION

(37 C.F.R. 1.8)

I HEREBY CERTIFY that this Amendment A, including Introductory Comments, Amendments to the Specification, Amendments to the Claims, and Remarks, is being transmitted by facsimile to the United States Patent and Trademark Office, Central Fax, Attn: Mr. Sing P. Chan, (571) 273-8300 on January 11, 2006.

Dated: January 11, 2006


April Turley